

Remarks**I. THE OFFICE MUST RESPOND TO THE REMARKS RE: NOTICE RE: BENEFIT**

Assignee notes that the Office Action does not respond to the remarks on page 3 of the paper filed October 18, 2004, regarding the meaning of the Notice mailed September 13, 2004. The Examiner had, in an interview, promised to inquire further about the notice and respond to assignee's representative. As indicated, assignee respectfully requests the Office to confirm that the claim that this is the National Stage of a PCT application is now in proper form, withdraw the Notice, or clarify specifically what it perceives as the problem. Assignee also respectfully requests that Examiner Poinvil confirm that he has granted the priority date of the provisional applications that disclose the invention of each claim, one of which was filed April 15, 1999, and the other of which was filed January 13, 2000, for purposes of examination.

II. THE OFFICE SHOULD RECONSIDER AND ALLOW ALL CLAIMS.

Generic claim 62 stands rejected as obvious over either Gregory or Troy, in view of a 1988 article from CD Computing News ("the Rebate Article"). In essence, the Office Action cites Gregory and Troy as disclosing "means for printing a financial instrument at a user terminal from a central source." The Rebate Article shows a conventional rebate program. The Office Action apparently cites the Rebate Article as further showing the specific requirements of parts (a)(1)-(2) of claim 62, which relate to agreement by the user to accept specific terms of use for the product and performance by the user of a legally binding action (*see* dependent claims 63-65 for an *example* of one legally binding action). The Office Action refers assignee to the sentence in the Rebate Article stating that, "Consumer rebate fulfillment is subject to terms and conditions listed on the rebate coupon." This unexplained sentence, without any knowledge of the referenced "terms and conditions listed," does not meet the specific requirements of parts (a)(1)-(2). Thus, the Office Action does not contain reasoning that meets the Office's duty to provide a *prima facie* case of obviousness, necessary to maintain a rejection of this kind.

Perhaps more critically, even assuming that it is known that certain rebate transactions may have features that match parts (a)(1)-(2), the Office Action does not provide a sufficient motivation or suggestion for applying the decentralized printing

systems of Gregory or Troy to print rebate coupons. The Office Action states that such a combination would have been obvious "to provide instant credit or coupons to customers or users once they have fulfilled certain conditions thereby allowing instant uses of the coupons or rebates." Office Action, p. 3. However, without reference to applicants' specification, the Office Action cites no reference that reveals any desire for any rebate provider to provide instant credit or coupons to consumers, or for consumers to receive their rebates faster. The Examiner may have had personal experience with the usual "six to eight weeks" for rebates to arrive. Delays of that kind have persisted for decades, without any significant movement by the industry to shorten the time lag. There is no generally recognized and accepted desire for customers or rebate providers to shorten the time to achieve "instant uses." Speeding up rebate coupons or checks simply was not "on the radar" of the ordinarily skilled artisan as something desirable to do – for example, rebate payors do not generally compete publically on who can fulfill their rebates faster.

In the absence of any generally understood desire to speed up rebates, it is not understood why an ordinarily skilled artisan would have thought of applying decentralized printing systems of Gregory or Troy to rebates. The specific disclosures of those references indeed emphasize the distinction from the present claim 62. Gregory discloses a system for printing employee paychecks – it is generally understood that employees wish to receive their paychecks immediately. Gregory also discloses a system for printing site-specific coupons – he explains that there is a desire to print coupons that can be cashed at a specific site and at a specific time. Troy discloses a decentralized system for printing winning lottery checks, to achieve "excitement and/or anticipation of a check being printed" without delay, as compared to the "inhibiting effect on initial and/or continued play" that results from the usual "substantial time lapse from time of win to point of collection" in ordinary lotteries, especially for "out of town winners." Troy, Col. 3, liners 25-28, 41-48. In each of those cases, there are good reasons explained why one would desire to print what the Office Action describes as "the financial instrument" quickly. This contrasts with the rebate pay-offs, where such motivation for quickness has not been generally recognized.

The absence of such motivation or suggestion is fatal to the rejection. Where the Office has not identified any motivation and suggestion of advantages, a Section 103 rejection cannot stand. *See, e.g., In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999) (reversing rejection because "the [PTO] did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references"); *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000) ("Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference"); *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness "only by showing some objective teaching" leading to the modification); *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989) ("the mere fact that the prior art could be ... modified" to form a claimed structure "would not have made the modification obvious unless the prior art suggested the desirability of the modification") (numerous citations omitted).

The mere fact that each of the elements can be found in a reference and has previously known benefits does not provide the requisite "motivation" or "incentive" to modify the teachings of a reference. *E.g., Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 959 (Fed. Cir. 1986) ("That each element in a claimed invention is old or unpatentable does not determine the nonobviousness of the claimed invention as a whole. There is no basis in law for treating combinations of old elements differently in determining patentability") (citation omitted).

Rather, the test for obviousness is based on what one skilled in the art would know *as of the time of the invention*, not what a specialist (such as the Examiner) can determine using the "20-20 hindsight" available from the years of development of the field since the invention date. *E.g., In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999) ("Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field," and "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to

combine prior art references"); In re Kotzab, 217 F.3d 1365, 1369 (Fed. Cir. 2000) ("the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher").

Finally, the burden of making the required showings is on the Examiner, not applicant. E.g., In re Rouffet, 149 F.3d 1350, 1359 (Fed. Cir. 1998) ("the [PTO] must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them").

As a result of the above points, the Office should reconsider and withdraw the rejections and allow generic claim 62. All examined claims rely on the proposed combination of Gregory or Troy with the Rebate Article; thus, all examined claims should be similarly allowable. Furthermore, claims 80-86 should be allowed as well, as those have been withdrawn from consideration as a non-elected species, not restricted, and have been determined to be "embraced by" claim 62 and include the key limitations of claim 62 (plus the element of an "incentive" in exchange for a survey response). After allowance of generic claim 62, therefore, the non-elected species embodied by claims 80-86 should be similarly allowable. See MPEP 809.02(c)(B)(1) and form paragraph 8.50.

Assignee respectfully submits that all claims 62-90 stand in condition for prompt allowance.

III. THE OFFICE SHOULD ALTERNATIVELY ALLOW CERTAIN CLAIMS.

The Office Action does not support a proper obviousness rejection as to certain dependent or other claims. In the event that the above does not suffice to allow all claims, the Examiner should reconsider the rejections of certain claims, in accordance with the notes below.

Claims 63-65 and 77-79 relate to removable opaque material. The Office Action, p. 3, refers to such systems used on "certain products such as software products." No reference or citation is given to support this comment. Assignee respectfully traverses the assertion, as well as points out that, even if true, the existence of such covered codes on software products does not obviate the different uses with respect to rebates in these claims.

Claim 69 refers to security markings that change appearance when optically duplicated. The Office Action, p. 4, refers to a supposed "suggestion" by Gregory related to distinctive marks on the paper on which the checks are printed. Nothing is said about resistance to duplication, in Gregory, however.

Claims 71-73 refers to "downloading software from the server to the user terminal to signify a guarantee by the intermediary of the availability of the funds," which software causes the computer to print the rebate coupon. The Office Action, p. 7, admits that this feature is missing from the three combined references but cites Custy as allegedly disclosing it. A review of the cited portions of Custy reveals, however, that Custy does not disclose "downloading software," as opposed to merely inputting security codes in existing software, or the downloading "signify[ing] a guarantee" by any intermediary.

Claim 74 refers to an intermediary, which is identified by the indicia. The Office Action, pp. 4-5, refers to Gregory or Troy as disclosing an intermediary. The cited places do not reveal an "intermediate entity [that] controls funds of the financial account," and the Office Action's statement that the "central server" of Gregory or Troy "*may* act as an intermediary" (emphasis added) does not prove sufficient disclosure to meet the claim. Moreover, in none of the cited locations do the reference disclose the feature in the claim of the indicia identifying the intermediary.

Claims 76, 79, and 90 refer to keeping a list of payees who have not already drawn their funds. The Office Action, p. 5, admits that neither of the three combined references disclose that feature but contends that it would have been "just plain obvious" to keep such a list, without citing any supporting reference. The Office Action argues that the motivation would be to avoid double-cashing of rebate coupons, for security and inventory. However, Gregory and Troy relate to printing financial instruments (paychecks, lottery payoffs, or immediately cashable coupons) designed for essentially immediate negotiation. There is no need to keep a list of authorized payees. In the claimed rebate system, by contrast, the payees may not negotiate the rebate coupons immediately.

IV. THE OFFICE SHOULD ALTERNATIVELY ALLOW THE DISTINCT SPECIES.

The Office has previously indicated that independent claim 87 and its dependent claims 88-90 constitute a patentably distinct species from independent claim 62. *See* Office Action dated 9/13/04. The Office Action, pp. 5-6, nevertheless rejects claim 87 based on the same combination of three references, despite that finding of patentable distinction, and despite failing to argue that any of the three references disclose explicitly the feature of providing the rebate coupon "in exchange for" the user "provid[ing] electronic work product." It appears that the Office Action's position is inconsistent with the Office's previous determination of patentable distinctness.

With regard to the element discussed above, the Office Action purports to find "electronic work product" in the alleged fact that "[a] user purchasing electronic apparel [sic?] or software is sometimes required to provide registration data to the manufacturer so that the manufacturer may control marketing data and consumer behavior." No reference or citation is given to support this assertion. Assignee respectfully traverses the assertion, as well as points out that, even if true, the existence of such registration data appurtenant to purchases of software products is not "electronic work product," and does not obviate the different concept of provision of rebates in exchange for such work, as in claim 87.

Finally, the added elements of claim 88, dependent on claim 87, is not addressed in the Office Action at all, yet it is included in the list of rejected. The Office should indicate allowability of this claim or else provide reasons for rejecting it.

If the Examiner has any questions, please feel free to contact assignee's undersigned attorney.

Respectfully submitted,

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by its attorney



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